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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/272,562	03/19/1999	SHAHRIAR ALAM	MDHS-378A	5836
826	7590	04/08/2004	EXAMINER	
ALSTON & BIRD LLP BANK OF AMERICA PLAZA 101 SOUTH TRYON STREET, SUITE 4000 CHARLOTTE, NC 28280-4000			SPERTY, ARDEN B	
			ART UNIT	PAPER NUMBER
			1771	

DATE MAILED: 04/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

A³

Office Action Summary	Application No. 09/272,562	Applicant(s) ALAM ET AL.	
	Examiner Arden B. Sperty	Art Unit 1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Change of power of attorney March 5, 04.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 21-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-11, 22, 23, 26 and 28 is/are rejected.
- 7) ☒ Claim(s) 6, 21 and 24-27 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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FIRST OFFICE ACTION FINAL

1. Claims 1-11 and 21-28 are currently pending.

Claim Rejections - 35 USC § 112

2. Claims 6, 21, 22 and 26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification does not describe layers of the claimed thicknesses or a B-stage resin in such a way that one of ordinary skill in the art would be able to make the invention.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 6 recites the range of "3 to 25 mm." There is insufficient antecedent basis for this limitation in the claim.

Claim 21 recites the range of "125 to 380 μ m" in regard to the thickness of the fibrous sublayer. There is insufficient antecedent basis for this limitation in the claim.

Claim 22 recites the limitation "a B-stage resin" in line 3. There is insufficient antecedent basis for this limitation in the claim. Furthermore, claims 22-23 and 26 are indefinite because it is not clear what is meant by a "B-stage resin."

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claims 1-11, 21-23, 25 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,403,422 to Kawai in view of USPN 5,714,526 to Whyzmuzis.

Regarding claims 1, 10-11, and 25, the Abstract of the Kawai reference discloses a base sheet (thin film carrier layer), a pattern layer (ink pattern), and an adhesive layer (adhesive material) formed on the pattern layer. The pattern layer comprises a composition of ink and resin (col 3, lines 31-35). The co-curability of the adhesive is shown at col 5, lines 21-33, specifically lines 31-33. Although the reference does not specifically disclose the ink containing an electrically resistive or conductive material as required by claims 1 and 10-11, the reference does teach a conventional printing ink (col 3, lines 31-35). The Whyzmuzis reference teaches ink pigments which exhibit the claimed properties (col 6, lines 37-62). It would have been obvious to use the inks of the Whyzmuzis reference in the invention of the Kawai reference motivated by the explicit teachings of the Kawai reference toward a conventional printing ink.

Regarding claims 2-5 and 28, the Kawai reference teaches a base sheet of paper, cloth, woven or nonwoven cloths of glass fiber or synthetic resin fiber (col 4, lines 44-49) (fibrous layer) with a thermosetting resin (col 4, lines 56-61).

Regarding claim 6, although Kawai does not specifically teach the claimed thickness range, the reference teaches that any base sheet which has been used for the conventional decorative plates may be used and may include the known materials of column 4, lines 44-55, materials which have thicknesses within the claimed range. Therefore, the limitation of the claim is anticipated.

Regarding claims 7-8 and 28, the Kawai reference teaches thermosetting resins at column 4, line 56-col 5, line 11.

Regarding claim 9, the Abstract of Kawai describes the invention as a decorative plate, therefore decorative shapes are anticipated. The specific shape, color, or other decorative aspect of the decoration is a matter of personal preference.

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Regarding claim 21, Kawai's thermosetting resin (continuous surface layer) is applied with a thickness of 25 μm (col 7, lines 2-3).

Regarding claims 22-23, Kawai teaches an epoxy resin (col 1, lines 9-16).

Allowable Subject Matter

6. Claims 24 and 26 contain allowable subject matter, and would be allowable if rewritten in independent form containing all of the limitations of the base claim and any intervening claims. While the combined references teach the invention of the above rejections, the references do not teach or fairly suggest the specific properties of claims 24 and 26.

Conclusion

7. All claims currently examined are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

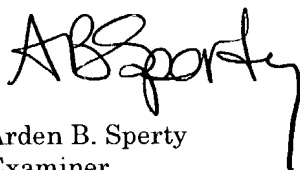
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arden B. Sperty whose telephone number is (571)272-1543. The examiner can normally be reached on M-Th, 08:00-16:00.

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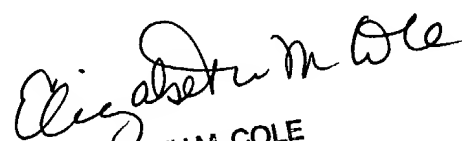
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571)272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Arden B. Sperty
Examiner
Art Unit 1771

25 March 2004


ELIZABETH M. COLE
PRIMARY EXAMINER